

REMARKS

I. Introduction

Claims 21 to 40 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Allowable Subject Matter

Applicants note with appreciation the indication of allowable subject matter included in claims 24, 25, 27 to 30, and 34. In this regard, the Examiner will note that claims 24, 25, 27, and 29 have been rewritten herein in independent form. As such, it is respectfully submitted that claims 24, 25, 27, and 29, as well as claims 28 and 30, are in condition for immediate allowance.

Regarding claim 34, which depends from claim 31, it is respectfully submitted that claim 34 is allowable for at least the reasons more fully set forth below in support of the patentability of claim 31.

III. Rejection of Claims 21 to 23 and 26 Under 35 U.S.C. § 102(b)

Claims 21 to 23 and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,348,772 ("May"). It is respectfully submitted that May does not anticipate the present claims as amended herein for at least the following reasons.

As an initial matter, the Examiner will note that claim 21 has been amended herein without prejudice to recite that a controllable light source is adapted to display arbitrarily changeable information items on a display layer of a rotary knob. Support for this amendment may be found, for example, on page 9, line 29 to page 10, line 25 of the Specification and Figures 5 to 8 and 11.

In stark contrast, May describes a rotary actuating element 3 having a display 9 and that the display 9 includes a plurality of LEDs 11 distributed uniformly over the circumference of the end face 10 of the rotary actuating element 3. The LEDs 11 are not adapted to display **arbitrarily changeable information items**. Rather, the LEDs 11 are driven without exception so that the user perceives the display 9 as a bright circle, or are driven individually to present to the user visually a

rotating sensation, or are driven to permit the user to make a logical association with the selected function.

It is, of course, “well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office.” Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In other words, to be anticipatory, a single prior art reference must show all of the limitations of the claims arranged or combined in the same way as recited in the claims. Net Moneyin, Inc. v. Verisign, Inc., 545 F.3d 1359 (Fed. Cir. 2008). As more fully set forth above, May does not disclose, or even suggest, all of the features included in claim 21. As such, it is respectfully submitted that May does not anticipate claim 21.

As for claims 22, 23, and 26, which depend from claim 21 and therefore include all of the features included in claim 21, it is respectfully submitted that May does not anticipate these dependent claims for at least the reasons more fully set forth above in support of the patentability of claim 21.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 31 to 33, 35, and 36 Under 35 U.S.C. § 103(a)

Claims 31 to 33, 35, and 36 were rejected under 35 U.S.C. § 103(a) over the combination of May and U.S. Patent No. 7,038,147 (“the ’147 patent”). It is respectfully submitted that the combination of May and the ’147 patent does not render unpatentable the present claims for at least the following reasons.

The ’147 patent issued on **May 2, 2006** from U.S. Patent Application Serial No. 10/820,267, filed on **April 8, 2004**. The present application claims the benefit of U.S. Provisional Application No. 60/512,866, filed on **October 20, 2003**, which is **before** both the **May 2, 2006** issue date of the ’147 patent and the

April 8, 2004 filing date of the '147 patent. Accordingly, the '147 patent does not constitute prior art against the present application. As such, the present rejection is entirely improper.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 37 to 40 Under 35 U.S.C. § 103(a)

Claims 37 to 40 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of May, the '147 patent, and U.S. Patent No. 5,335,743 ("Gillbrand et al."). It is respectfully submitted that the combination of May, the '147 patent, and Gillbrand et al. does not render unpatentable the present claims for at least the following reasons.

As more fully set forth above, the '147 patent does not constitute prior art against the present application. As such, the present rejection is entirely improper.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: January 12, 2010

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646

- C. Any additional document supply fees under 37 C.F.R. § 1.19;
- D. Any additional post-patent processing fees under 37 C.F.R. § 1.20; or
- E. Any additional miscellaneous fees under 37 C.F.R. § 1.21.

Respectfully submitted,

Date: January 12, 2010

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646